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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,353	12/18/2001	Victor I. Deonarine	ITW7510.008	3939
33647	7590	04/15/2005	EXAMINER	
ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (ITW)			JAGAN, MIRELLYS	
14135 NORTH CEDARBURG ROAD			ART UNIT	
MEQUON, WI 53097			PAPER NUMBER	
			2859	

DATE MAILED: 04/15/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/683,353
Filing Date: December 18, 2001
Appellant(s): DEONARINE, VICTOR I.

John Wilkinson
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed 2/27/04 and Supplemental Brief filed 9/22/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief (see the Supplemental Brief filed 9/22/04, page 3, section 6, 1st paragraph) is not correct. The changes are as follows:

Issue No. 1: Whether claims 1, 6, 8, 16, and 18-20 are anticipated under 35 U.S.C. §102(b) by "OMEGAMARKER[®] Temperature Test Kit" by OMEGA[®].

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Issue No. 2: Whether claims 1, 3, and 6 are anticipated under 35 U.S.C. §102(b) by U.S. Patent 6,022,159 to Kossnar et al.

Issue No. 3: Whether claims 1, 3, 5, 6, 8, and 9 are anticipated under 35 U.S.C. §102(b) by U.S. Patent 3,564,668 to Kirk.

Issue No. 4: Whether claims 1, 3, 5, 6, and 8 are anticipated under 35 U.S.C. §102(b) by U.S. Patent 4,244,660 to Aronson.

Issue No. 5: Whether claim 17 is unpatentable under 35 USC §103(a) over “OMEGAMARKER[®] Temperature Test Kit” by OMEGA[®] in view of U.S. Patent 1,603,713 to Peterson.

There are no issues with respect to claims 2 and 10-15 over “OMEGAMARKER[®] Temperature Test Kit” by OMEGA[®] in view of U.S. Patent 1,603,713 to Peterson since the rejections of claims 2 and 10-15 have been withdrawn.

There are no issues with respect to claim 5 over Kossnar et al since the rejection of claim 5 over Kossnar et al has been withdrawn.

(7) *Grouping of Claims*

Appellant's brief (Supplemental Brief filed 9/22/04) includes a statement that claims 1-3, 5, 6, and 8-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

A substantially correct copy of appealed claim 11 appears on the third page of the Appendix to the appellant's brief. The minor errors are as follows:

Applicant's amendment filed 9/22/04 has been entered since it was in response to a non-final rejection. In the amendment of 9/22/04, Applicant amended only claim 11 by changing "second element" to --second housing element--. Therefore, claim 11 of the Appendix should also state --a second housing element-- in line 3 since the amendment to claim 11 has been entered.

(9) Prior Art of Record

Omega[®] Engineering Inc., "The Temperature Handbook", Vol. 29, pg. F-10
(Omegamarker[®] Temperature Test Kit), 1995.

U.S. Patent 6,022,159	Kossnar et al.	02-2000
U.S. Patent 3,564,668	Kirk	02-1971
U.S. Patent 4,244,660	Aronson	01-1981
U.S. Patent 1,603,713	Peterson	01-1926

(10) Grounds of Rejection

1. Claims 1, 6, 8, 16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by the publication titled "OMEGAMARKER[®] Temperature Test Kit" by OMEGA[®]. This rejection is set forth in a prior Office Action, mailed on 6/22/04.

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2. Claims 1, 3, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,022,159 to Kossnar et al.

Kossnar et al disclose an assembly comprising:

a first housing (32a) positioned along a first axis and configured to hold a compound that melts at a first temperature;

a second housing (32b) positioned along a second axis and configured to hold a second compound that melts at a second temperature; and

a one-piece connector (10) physically connecting the first and second housings along different axes;

wherein the connector comprises a longitudinal member having curved ends configured to slidably secure the housings to the connector in a side-by-side relationship (see figure 2).

Furthermore, referring to claim 1, the term “configured to” is not considered to be a positive structural limitation since it only requires the ability to so perform, i.e., the housings of Kossnar et al are “configured to” hold a compound that melts at a given temperature since such a compound can be held by the housings, if so desired.

3. Claims 1, 3, 5, 6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,564,668 to Kirk. This rejection is set forth in a prior Office Action, mailed on 6/22/04.

4. Claims 1, 3, 5, 6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,244,660 to Aronson. This rejection is set forth in a prior Office Action, mailed on 6/22/04.

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the publication titled "OMEGAMARKER® Temperature Test Kit" by OMEGA® in view of U.S. Patent 1,603,713 to Peterson.

OMEGA® discloses an apparatus comprising all of the limitations of claim 17, as stated above with respect to claims 1, 6, 8, 16, and 18-20, except for the apparatus having means for controlling the movement of the first and second means for indicating temperature.

Peterson discloses a device for holding a crayon. Peterson teaches a mechanism for controlling the movement of a crayon within a holder. The mechanism comprises a collet (5) having threads for screwing onto the end of the holder, and a plurality of resistance mechanisms formed in the holder (arms) that are pressed together against the crayon by the collet to engage the crayon (which will limit rotational movement). Peterson teaches that it is useful to provide such a mechanism since it allows a user to control the movement of the sticks, i.e., allows a user to extend or retract the crayon a desired distance from or into the holder, in order to store or protect the crayon.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by OMEGA® by adding a mechanism for controlling the movement, as taught by Peterson, of the first and second means for indicating temperature from a corresponding part of the retaining means in order to allow a user to extend or retract the means for indicating temperature a desired distance from or into the retaining means when marking a surface with the means for indicating temperature.

(11) Response to Argument

Issue No. 1:

Applicant's arguments in the Appeal Briefs filed 2/27/04 and 9/22/04 with respect to the rejection of claims 1, 6, 8, 16, and 18-20 over "OMEGAMARKER® Temperature Test Kit" by OMEGA® have been fully considered but they are not persuasive.

Claim 1:

In the Appeal Brief filed 2/27/04(see the last paragraph on page 4-page 6), Applicant argues that OMEGA® does not anticipate claim 1 because OMEGA® includes a plurality, i.e., more than two, temperature indicating sticks, and therefore does not form a "dual temperature stick" assembly. However, claim 1 claims an assembly comprising a first and a second housing and a connector connecting the two housings, wherein each housing is configured to hold a compound that melts at a first and second temperature, respectively. These limitations are all disclosed by the assembly of OMEGA®, since the OMEGA® assembly comprises a first and a second housing and a connector connecting the two housings, as explained in the rejections, wherein each housing holds a compound that melts at a first and a second temperature. Although OMEGA® shows that the assembly is capable of having more than two housings connected together by the connector, this does not preclude the assembly from having only two housings, thereby forming the 'dual' temperature indicator stick assembly referred to by the Applicant throughout his arguments.

Furthermore, Applicant's arguments that OMEGA® does not anticipate claim 1 because the "case" of OMEGA® is not a "connector" are not persuasive. First, according to Webster's Dictionary, 10th ed. "connect" is defined as "to join or fasten together usually by something intervening". Therefore, the casing of OMEGA® is, by definition, is also a "connector" since it

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connects together the housings of the test kit. Secondly, Applicant's 'connector' connects the housings together by providing a snap-fit retention in which the housings are inserted and held in place, thereby connecting them together. Therefore, the casing of OMEGA[®] is, by Applicant's description, also a "connector" since the case of OMEGA[®] connects the housings together by providing a snap-fit retention in which the housings are inserted and held in place, thereby connecting them together.

In addition, Applicant argues (see the last paragraph on page 6-page 8 in the Appeal Brief filed 2/27/04) that OMEGA[®] fails to disclose a "dual temperature indicator stick assembly", as called for in claim 1, because "the indicator sticks [are] removably contained within the case" and are therefore "not positioned for use in such a position", i.e., Applicant considers that the OMEGA[®] assembly is not a 'dual temperature indicator stick assembly' because the individual housings must be removed from the connector in order to use them for indicating temperature. However, Applicant's arguments are not persuasive since the manner in which the assembly is to be used is not a structural limitation of the assembly claimed in claim 1. Although the housings of the OMEGA[®] assembly are used in a different manner than in the Applicant's assembly to indicate temperature, OMEGA[®] still discloses an assembly that meets all of the claimed structural limitations of claim 1, as stated in the rejections and the response to Applicant's arguments above.

Lastly, the Examiner's statements regarding the recitation of the phrase "dual temperature indicator stick" in the preamble was used by the Examiner as an attempt to explain to the Applicant that he is not positively claiming any sticks in the body of claim 1. However, whether the 'sticks' are positively claimed or not in claim 1 is moot with respect to OMEGA[®] since

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OMEGA[®] discloses housings each containing a temperature indicating material, i.e., discloses temperature indicating sticks.

Claim 6:

Applicant argues in the Appeal Brief filed 2/27/04 (see pages 10-11) that OMEGA[®] fails to disclose a connector that slidably secures the housings, as called for in claim 6, because the housings of OMEGA[®] are secured in respective channels of the case, which will prevent the housings from sliding therein. However, Applicant's arguments are not persuasive since, firstly, the housings are frictionally held in the 'channels' of OMEGA[®], and therefore can be slidably moved within the channels, even if only slightly, by, for example, applying an axial force at either end of the housing; and secondly, the housings of OMEGA[®] are considered to be 'slidably secured' by the connector (case) since, as in Applicant's connector, the connector connects the housings together by providing a snap-fit retention in which the housings are slid into and secured in place (slidably secured).

Applicant's additional arguments in the Supplemental Brief filed 9/22/04 (see pages 7-8) that OMEGA[®] fails to anticipate claim 6 because the individual housings must be removed from the connector in order to use them for indicating temperature are not persuasive because the manner in which the assembly is to be used is not a structural limitation of the assembly claimed in claim 6. Although the housings of the OMEGA[®] assembly are used in a different manner than in the Applicant's assembly to indicate temperature, OMEGA[®] still meets all of the claimed structural limitations of claim 6, as stated in the rejections and the response to Applicant's arguments above.

Claim 16:

Applicant's arguments in the Appeal Brief filed 2/27/04 that that OMEGA[®] fails to disclose an assembly capable of indicating at least two temperatures, as called for in claim 16, are not persuasive since the manner in which the assembly is to be used is not a structural limitation of the assembly claimed in claim 16. Although the OMEGA[®] assembly is used in a different manner than the Applicant's assembly to indicate temperature, the assembly of OMEGA[®] is capable of measuring temperature, and therefore meets all of the claimed structural limitations of claim 16, as stated in the rejections and the response to Applicant's arguments above.

Lastly, Applicant's additional arguments in the Supplemental Brief filed 9/22/04 (see pages 7-8) referring to the recitation of the phrase "dual temperature indicator stick" in the preamble of claim 16 are moot with respect to OMEGA[®] since OMEGA[®] discloses a first and a second means (first and second crayons) for indicating a first and a second temperature and means for retaining them as claimed in claim 16, i.e., OMEGA[®] discloses a 'dual temperature indicating stick' apparatus as claimed in claim 16.

Issue No. 2:

Applicant's arguments in the Supplemental Brief filed 9/22/04 with respect to the rejection of claims 1, 3, and 6 over U.S. Patent 6,022,159 to Kossnar et al have been fully considered but they are not persuasive.

Claim 1:

Applicant argues (see page 9) that the term "configured to" in claim 1 is a structural limitation to perform the stated function (the stated function referred to by Applicant appears to be holding a compound) because functional terms or limitations must be evaluated and

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considered like any other limitation in the claim (citing MPEP 2173.05(g)) and anticipation requires that each and every element be found in a single reference (citing MPEP 2131).

However, these arguments are not persuasive because the term “configured to” fails to positively add any structural elements to the claim. The term only requires that the housings have *any* construction as long as that they can hold a compound, such as a compound that melts at given temperatures, thereby being ‘configured’ to hold the compound.

Furthermore, Applicant’s housings are ‘configured to’ hold a compound that does not melt at a given temperature, e.g., are configured to hold a material that does not have temperature-indicating capabilities. Therefore, it is not clear from Applicant’s arguments what particular ‘structural limitation’ he considers to be claimed in claim 1 by the term ‘configured to’. In this case, the housings of Kossnar et al are ‘configured to’ hold a marking tip (66), but are also capable of holding other types of marking tips, such as a tip of a compound that melts at a given temperature. Therefore, the housings of Kossnar et al are considered to be ‘configured to’ hold a compound that melts at a given temperature.

Lastly, it is noted that features upon which applicant relies, i.e., the assembly comprising a compound that melts at a first temperature and a compound that melts at a second temperature, are not positively claimed in claim 1.

Claim 3:

Applicant argues (see page 10) that connector of Kossnar et al fails to disclose the limitations of claim 3, i.e., fails to disclose a connector comprising a longitudinal member having curved ends that are configured to secure the first and second housings to the connector, because the tubes (20a, 20b) of the connector are what secures the pens to the connector and not the

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curved ends (54) of the longitudinal member (14). However, these arguments are not persuasive since the rejection is based on the curved ends of the longitudinal member being configured to secure the housings to the connector by the tubes 20a, 20b, i.e., the curved ends (54) do not secure the housings, but are configured to hold the housings by the tubes (20a, 20b), which are integrally formed therewith.

Claim 6:

Applicant argues (see page 11) that connector of Kossnar et al fails to disclose the limitations of claim 6, i.e., fails to disclose a connector that slidably secures the first and second housings, because the housings of Kossnar et al are either secured or sliding relative to the connector, but not both as claimed in claim 6. However, these arguments are not persuasive since this feature upon which applicant relies, i.e., the housings being slidable while secured to the connector, is not claimed in claim 6. Claim 6 claims that the connector “slidably secures” the housings, which is disclosed by Kossnar et al since the housings are slid into the connector in order to be secured therein, thereby slidably securing the housings.

Issue No. 3:

Applicant's arguments in the Supplemental Brief filed 9/22/04 with respect to the rejection of claims 1, 3, 5, 6, 8, and 9 over U.S. Patent 3,564,668 to Kirk have been fully considered but they are not persuasive.

Claim 1:

As similarly stated for the Kossnar et al reference above, the Applicant argues (see pages 11-12) that the term “configured to” in claim 1 is a structural limitation to perform the stated function (the stated function referred to by Applicant appears to be holding a compound).

However, these arguments are not persuasive because the term “configured to” fails to positively add any structural elements to the claim. The term only requires that the housings have *any* construction as long as that they can perform the function of holding a compound, thereby being ‘configured’ to hold the compound. Furthermore, Applicant’s housings are ‘configured to’ hold a compound that does *not* melt at a given temperature, e.g., are configured to hold a material that does not have temperature-indicating capabilities. Therefore, it is not clear from Applicant’s arguments what particular ‘structural limitation’ he considers to be claimed in claim 1 by the term ‘configured to’.

In this case, the housings (20) of Kirk are ‘configured to’ hold a marking tip, e.g., graphite compound, but are also capable of holding other types of marking tips, such as a tip of a compound that melts at a given temperature. Therefore, the housings of Kirk are considered to be ‘configured to’ hold a compound that melts at a given temperature.

In addition, Applicant’s arguments that Kirk fails to anticipate claim 1 because the individual housings must be removed from the connector in order to use them are not persuasive because the manner in which the assembly is to be used is not a structural limitation of the assembly claimed in claim 1. Although the housings of the Kirk assembly are used in a different manner than in the Applicant’s assembly to mark a surface, Kirk still meets all of the claimed structural limitations of claim 1.

Lastly, it is noted that features upon which applicant relies, i.e., the assembly comprising a compound that melts at a first temperature and a compound that melts at a second temperature, are not positively claimed in claim 1.

Issue No. 4:

Applicant's arguments in the Supplemental Brief filed 9/22/04 with respect to the rejection of claims 1, 3, 5, 6, and 8 over U.S. Patent 4,244,660 to Aronson have been fully considered but they are not persuasive.

Claim 1:

As similarly stated for the Kossnar et al reference above, the Applicant argues (see pages 12-13) that the term “configured to” in claim 1 is a structural limitation to perform the stated function (the stated function referred to by Applicant appears to be holding a compound). However, these arguments are not persuasive because the term “configured to” fails to positively add any structural elements to the claim. The term only requires that the housings have *any* construction as long as that they can perform the function of holding a compound, thereby being ‘configured’ to hold the compound. Furthermore, Applicant’s housings are ‘configured to’ hold a compound that does *not* melt at a given temperature, e.g., are configured to hold a material that does not have temperature-indicating capabilities. Therefore, it is not clear from Applicant’s arguments what particular ‘structural limitation’ he considers to be claimed in claim 1 by the term ‘configured to’.

In this case, the housings of Aronson are ‘configured to’ hold a marking tip, e.g., graphite compound, but are also capable of holding other types of marking tips, such as a tip of a compound that melts at a given temperature. Therefore, the housings of Aronson are considered to be ‘configured to’ hold a compound that melts at a given temperature.

In addition, Applicant’s arguments that Aronson fails to anticipate claim 1 because the individual housings must be removed from the connector in order to use them are not persuasive because the manner in which the assembly is to be used is not a structural limitation of the

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assembly claimed in claim 1. Although the housings of the Aronson assembly are used in a different manner than in the Applicant's assembly to mark a surface, Aronson still meets all of the claimed structural limitations of claim 1.

Lastly, it is noted that features upon which applicant relies, i.e., the assembly comprising a compound that melts at a first temperature and a compound that melts at a second temperature, are not positively claimed in claim 1. Furthermore, Applicant's arguments that the Examiner has admitted that Aronson fails to show, disclose, or suggest a holder configured to hold a compound that melts at a given temperature are not persuasive since the Examiner has not presented such an admission anywhere in the rejection over Aronson.

Issue No. 5:

Applicant's arguments in the Supplemental Brief filed 9/22/04 with respect to the rejection of claim 17 over "OMEGAMARKER[®] Temperature Test Kit" by OMEGA[®] in view of U.S. Patent 1,603,713 to Peterson have been fully considered but they are not persuasive for the reasons stated above with reference to claim 16 in Issue No. 1.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

MJ
April 12, 2005

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